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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/708,658	03/17/2004	Rodrick A. HERDMAN	EZL-001M	2657
26868	7590	06/28/2007		
HASSE & NESBITT LLC 8837 CHAPEL SQUARE DRIVE SUITE C CINCINNATI, OH 45249			EXAMINER GALL, LLOYD A	
			ART UNIT 3676	PAPER NUMBER
			MAIL DATE 06/28/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/708,658

Applicant(s)

HERDMAN, RODRICK A.

Examiner

Lloyd A. Gall

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6, 9-12, 22, 23, 44-55 and 57-75 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6, 9-12, 22, 23, 44-55 and 57-75 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 3/17/04 and 1/9/06 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>6/4/2007</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

In view of the prior art filed by applicant in the IDS of June 4, 2007, it is regretted that the previous indication of allowable subject matter is withdrawn.

Claims 1, 60, 63, 68, 70 and 72 are objected to because of the following informalities: In claim 1, line 29, --tool-- should be inserted after the second occurrence of "change". In claim 60, line 17, "subset" should read --set--. In claim 63, line 3, "subset" should read --set--. In claim 68, line 18, "subset" should read --set--. In claim 70, line 5, "subset" should read --set--. In claim 72, line 9, "subset" should read --set--. In claim 72, line 10, there is no antecedent basis for "the periphery". Appropriate correction is required.

Claims 1-4, 6, 9-12, 22, 23, 44-55 and 57-75 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-16 and 19-22 of copending Application No. 11/178,627. Although the conflicting claims are not identical, they are not patentably distinct from each other because they substantially claim the same subject matter, and claims 1-16 and 19-22 of the '627 application fully encompass the subject matter of the claims of the instant application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-4, 6, 9-12, 22, 23, 44-55 and 57-75 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over

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claims 1-17 and 21-23 of copending Application No. 11/192,755. Although the conflicting claims are not identical, they are not patentably distinct from each other because they substantially claim the same subject matter, and claims 1-17 and 21-23 of the '755 application fully encompass the subject matter of the claims of the instant application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-4, 6, 9-12, 22, 23, 44-55 and 57-75 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-8 of copending Application No. 11/374,299. Although the conflicting claims are not identical, they are not patentably distinct from each other because they substantially claim the same subject matter, and claims 1-8 of the '299 application fully encompass the subject matter of the claims of the instant application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir.

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1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 6, 9-12, 22, 45-52, 55, 58-60, 63-65 and 68-72 are rejected under 35 U.S.C. 103(a) as being unpatentable over Monahan (002) in view of the EP (124) reference.

Monahan teaches a lock including a housing 30, a plug 34, springs 49, drivers 44, pins 45, plural keys regarded as user keys of a set, a programming key and a master key with different (raised and lowered) contour edges received in the keyway passage 62, a change tool slot 52, a change tool 51, change members 47 moved by the change tool as seen in figure 14 after the plug is rotated. Monahan also teaches a shim defined by the topmost wafer 47 as seen in figure 12. With respect to paragraph "e)" of claim 6, for example, the lock of Monahan is capable of being reconfigured solely in response to a key, by removing the change tool such as in the figure 11 condition, and then inserting a

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key, rotating the key, and allowing a change member 47 to fall within the retainer cavity. As seen in figure 17, the EP (124) reference teaches using a ball (e) as a change member with a retainer cavity (f). It would have been obvious to substitute a ball in place of, or in addition to, the plural change member discs 47 of Monahan, in view of the teaching of the EP (124) reference, the motivation being to prevent jamming between the topmost disc 47 in the retainer cavity and the shear line in the figures 13 and 14 position of Monahan.

Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Monahan in view of the EP (124) reference as applied to claim 22 above, and further in view of Smith (188).

In fig. 94, Smith teaches a shim 583 of a first diameter and a retainer cavity 545 of a second, smaller diameter. It would have been obvious to use a larger diameter shim with a retainer cavity of Monahan, in view of the teaching of Smith, the motivation being to control how many change members may enter a change cavity, in reprogramming a lock.

Claims 44, 57, 61, 62 and 73-75 are rejected under 35 U.S.C. 103(a) as being unpatentable over Monahan in view of the EP (124) reference as applied to claims 1, 6, 60 and 72 above, and further in view of an additional teaching of the EP (124) reference.

As seen in fig. 17, the EP (124) reference also teaches drivers pins (b) larger than the opening of the retainer cavity (f). It would have been obvious to form the retainer cavity of Monahan smaller than the driver chambers for use with the change member balls of

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Monahan as modified by the EP (124) reference, in view of an additional teaching of the EP (124) reference, the motivation being to prevent jamming of the lock at the shear line by the drivers and the retainer cavity.

Claims 53, 54, 66 and 67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Monahan in view of the EP (124) reference as applied to claims 1 and 60 above, and further in view of an additional teaching of Monahan and Smith. Monahan also teaches master shims defined by the topmost wafer 47 as seen in fig. 12. In fig. 94, Smith teaches a shim 583 of a first diameter and a retainer cavity 545 of a second, smaller diameter. It would have been obvious to use a larger diameter shim with a retainer cavity of Monahan, in view of the teaching of Smith, the motivation being to control how many change members may enter a change cavity, in reprogramming a lock.

In response to applicant's REMARKS on page 18, the first paragraph of April 18, 2007, it is not clear why the double patenting rejections are regarded as premature, or why the claims of the copending applications are not obvious over the present application. To advance the prosecution of the present application, applicant is required to substantially address the double patenting rejections in the next response.


The DECLARATION filed on June 4, 2007 by applicant has been reviewed by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lloyd A. Gall whose telephone number is 571-272-7056. The examiner can normally be reached on Monday-Friday, 8:30-5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Glessner can be reached on 571-272-6843. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Lloyd A. Gall
Primary Examiner
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LG LG
June 24, 2007